

III. REMARKS

Claims 1 -12 are currently pending in the instant application and are subject to a restriction requirement.

Election/Restriction

The examiner requires restriction to one of the following two groups:

I. Claims 1-9, drawn to compounds and compositions of the formulas I and I' of claim 1, classified in class 548.

II. Claims 10-12, drawn to methods of using the compounds, classified in class in multiple subclasses of class 514.

Inventions I and II are related as product and process of use.

Applicant elects group I drawn to compounds and compositions of formulas I and I'.

Restriction within the Elected Group

The examiner states that the Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. The examiner further states that the application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually, regarding the formulas I and I' of claim 1.

Applicant respectfully disagrees and notes that perusal of the structures of compounds I and I' demonstrates that formula I defines only 1 compound and formula I' only a handful of compounds, easily listed individually, along with their optically distinct variations and salts.

The examiner cites the decisions of *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984), which provide a basis for restriction within a Markush group. As specified in these decisions, restriction within a Markush group is only proper where the compounds within the group either

(1) do not share a common utility, or

(2) do not share a substantial structural feature disclosed as being essential to that utility.

The compounds of the present application do not meet either of the tests as required by the case law. First, the compounds all share a common utility, as specified on page 1, paragraph 5, of the specification where it is stated:

"Surprisingly it has been found that substituted pyrazoline compounds of formula I and formula I' show improved antitumoral activity in the treatment of cancer, especially of colon and/or prostate cancer, ..."

Therefore test (1) of the case law is not met.

The compounds of the present invention do share a common structural feature as is evident from the structural formula of compounds I and I'. The entire backbone of the two compounds is identical, with only two pendent groups being dissimilar. Even the location of pendent groups R2 and R4 is identical. The only difference in location is that group R1 is ortho to the nitrogen containing ring and R3 is meta to the nitrogen containing ring.

Therefore test (2) of the case law is not met.

Applicant therefore respectfully requests that all the compounds of elected Group I may be examined together and that the examiner has not the burden of providing a proper rationale for dividing the Markush group.

Notwithstanding the above, applicant elects, as a single compound for prosecution, the compound defined in claim 6.

Applicant reserves the right to file divisional applications on the remaining subject matter.

For all of the foregoing reasons, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

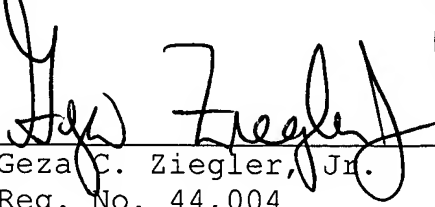
The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

USSN 10/804,695

Response to Restriction Requirement dated September 27, 2005

Atty Docket: 785-011732-US (PAR)

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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